

Appln. No. 10/057,476

Amdt. in Resp. to Off. Act. of Aug. 7, 2003

UTILITY PATENT

B&amp;D No. P-TN-2547

## REMARKS

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Applicants have amended Claim 3 and canceled Claims 4-6. No new claims have been added. Not including the withdrawn claims, pending in the present application therefore is Claim 3.

The Examiner objected to the drawings because FIGS. 4A-4B do not "enable one to understand how the trigger lock is rotated as described in the specification." This objection is respectfully traversed.

As discussed in paragraph 0047 of the specification, trigger lock 26 is preferably "shaped like a ring" and "pivotally attached around valve 24 so that it pivots about valve 24." Persons skilled in the art will see valve 24 in FIG. 4 and recognize that trigger lock 26 preferably pivots about said valve. Furthermore, such persons will recognize that lock 26L is moved between the locking position of FIG. 4A, where the lock 26L is disposed between the housing 15 and trigger 21, and the bypassed position of FIG. 4B, where the lock 26L does not contact trigger 21. Persons skilled in the art will recognize that, in the embodiment shown in FIG. 4, trigger lock 26 pivots about valve 24 when moving between the two shown positions. Accordingly, FIG. 4 enables one skilled in the art on how the trigger lock is rotated. Therefore, no amendment to the drawings is necessary.

The Examiner rejected Claims 3-5 under 35 USC § 102(b) as being anticipated by US Patent No. 4,264,028 ("Austin"). In addition, the Examiner rejected Claim 6 under 35 USC §

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103(a) as being unpatentable over Austin in view of US Patent No. 5,823,395 ("Foster").

Reconsideration and withdrawal of these rejections are respectfully requested.

Independent Claim 3, as amended, calls for a fastener tool comprising a housing, a magazine connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a contact trip assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece, a trigger assembly pivotally attached to the housing for activating the driving mechanism, the trigger assembly being rotatable relative to the housing about a first axis, the trigger assembly comprising a main trigger pivotally attached to the housing, and a supplemental trigger pivotally attached to the main trigger, the supplemental trigger being movable by the contact trip assembly, the driving mechanism being activated only when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger, and a trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position, the trigger lock having a handle for moving the trigger lock between the first and second positions, the handle being rotatable with the trigger lock about the second axis.

Admittedly, Austin shows for a fastener tool comprising a housing, a magazine connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a trigger assembly pivotally attached to the housing for

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activating the driving mechanism, the trigger assembly being rotatable relative to the housing about a first axis, and a trigger lock disposed between the housing and the trigger assembly movable between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position, and the trigger lock having a handle for moving the trigger lock between the first and second positions. However, Austin does not show the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between the first and second positions, or the handle being rotatable with the trigger lock about the second axis. Furthermore, Austin does not show a supplemental trigger or a contact trip that can contact the supplemental trigger.

By contradistinction, Claim 3 calls for (a) "the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position ... and a second position," (b) "the trigger lock having a handle for moving the trigger lock between the first and second positions, said handle being rotatable with the trigger lock about the second axis," (c) "a contact trip assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece," and (d) "a supplemental trigger pivotally attached to the main trigger, the supplemental trigger being movable by the contact trip assembly, the driving mechanism being activated only when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger." Because Austin does not show such elements, it cannot anticipate Claim 3.

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To provide such elements, the Examiner relies on Foster, which relates to "manually operated pump dispensers." Foster, col. 1, lns. 4-5. However, the Examiner cannot combine Austin with Foster for three reasons. First, Foster is not analogous art. Second, no motivation or suggestion to combine Austin with Foster exists. Third, even if combined, the Austin/Foster device would not have all claimed elements.

Foster is not analogous art because a person of ordinary skill in the fastener tool arts would not look in the pump dispenser field for a solution. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (quoted by MPEP § 2141.01(a), at 2100-115 (Aug. 2001, 8<sup>th</sup> ed.)).

*Oetiker* provides a good example of what can be considered analogous prior art in the mechanical arts, which include the present invention. In *Oetiker*, the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The CAFC held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

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Similarly, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of preventing unintended triggering of the fastener tool by an adult, would reasonably be expected or motivated to look for a solution in the child-proof pump dispenser field. Just like the PTO was not allowed to bring in hooks from the garment fastening field into the hose clamp fastening field, the Examiner should not be allowed to bring in child-proof pumps from the pump dispenser field into the fastener tool field, especially where the Examiner has not provided any evidence that a person of ordinary skill would look in the pump dispenser bailing field. Applicants hereby request that the Examiner provide any evidence that persons skilled in the art would indeed act in such manner so that Applicants can fully prepare their argument in the event of an appeal to the Board is necessary.

Even if Foster is analogous art, the Examiner has failed to establish a *prima facie* case that it should be combined with Austin. According to MPEP § 2142, to establish a *prima facie* case of obviousness, there must be *inter alia* some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. MPEP § 2143, at 2100-124 to -125 (8<sup>th</sup> ed., rev. 1, Feb. 2003). Accordingly, "the prior art must suggest the desirability of the claimed invention." MPEP § 2143.01, at 2100-125. In the present case, the Examiner has pointed to no evidence that Austin and Foster suggest the desirability of the claimed invention.

Furthermore, combining Austin with Foster as suggested by the Examiner would violate the MPEP. According to MPEP § 2143.01, "if [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion

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or motivation to make the proposed modification.” MPEP § 2143.01, at 2100-126 (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

In the present case, Austin discloses an improved trigger locking mechanism that does not require “two hands to operate the [locking] mechanism and fire the tool.” Austin, col. 1, lns. 28-30. Thus, the intended purpose of Austin is to provide a fastener tool that can be activated with only one hand. The Examiner, however, suggests modifying Austin according to Foster by providing a trigger lock that requires the user to use two hands, one to hold the tool, the other to unlock the trigger. Accordingly, the proposed modification would render Austin undesirable for its intended purpose. Therefore, the claims cannot be rendered *prima facie* obvious.

Furthermore, Austin teaches away from incorporating the Foster lock. As mentioned above, Austin teaches that it is undesirable to have a trigger locking mechanism that requires “two hands to operate the [locking] mechanism and fire the tool.” Austin, col. 1, lns. 28-30. Accordingly, the person of ordinary skill in the art would not combine Austin with Foster as Austin teaches away from the type of locks taught by Foster. Because of this, no suggestion to modify exists, and thus Claim 3 cannot be rendered *prima facie* obvious.

Finally, even if Austin and Foster are combined, the combination does not teach all the claimed elements. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 (*citing In re Royka*, 180 USPQ 580 (CCPA 1974)). In the present case, neither Austin nor Foster show “a contact trip assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece,” or “a supplemental trigger pivotally attached to the main trigger, the supplemental trigger being movable by the contact trip assembly, the driving mechanism being activated only

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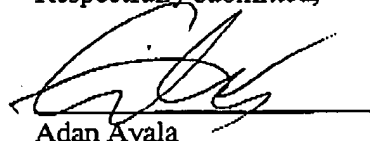
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when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger," as claimed. Accordingly, the Austin/Foster combination cannot render Claim 3 unpatentable.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claim 3 are respectfully requested.

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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